

REMARKS

I. Status of the Application.

Claim 1 and claims 3 through 12 were pending in the application (the "Present Invention") following the second non-final Office Action dated August 8, 2003 (the "Office Action"). In that Office Action, the Examiner: acknowledged the submission of an amendment filed on May 30, 2003; rejected Claims 1, 3, 4, 5, and 8-12 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Application No. 2001/0001596 to Goto (the "Goto reference") in view of U.S. Patent No. 4,841,419 to Ohishi (the "Ohishi patent"). The Examiner did not state a specific rationale for the rejection of claims 6 and 7, but inferred that claims 6 and 7 were rejected on the same grounds as Claims 1, 3, 4, 5, and 8-12.

In this response, the Applicant: (1) respectfully traverses the rejections of claims 1 and 3-12 made under 35 U.S.C. § 103(a); (2) respectfully submits amendments to claims 1, 8 and 9; and (3) adds new claims 13 through 18. Claims 1 and 3 through 12 remain in the application after the amendments. It is respectfully submitted that ample support may be found in Applicant's specification for the amendments to claims 1, 8 and 9, and the addition of claims 13 through 18.

II. Rejection of Claims 1 and 3 Through 12 Under 35 U.S.C. § 103(a) Should Be Withdrawn.

A. The Rejection of Claims 1 and 9 Under 35 U.S.C. § 103(a) Should Be Withdrawn.

In rejecting Applicant's claims 1 and 9, the Examiner asserted that all of the elements contained therein were anticipated by the Goto reference, in view of the Ohishi patent. Applicant respectfully submits that the rejection of amended claims 1 and 9 should be withdrawn, as the claim limitation of a light bulb holder in the form of a hollow tube positioned adjacent to the base portion of a lamp assembly where the hollow tube has a diameter that is smaller than the diameter of the light bulb, thereby preventing complete passage of the light bulb through the hollow tube is not mentioned in either the Goto reference or the Ohishi patent.

"To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art." M.P.E.P. § 2143.03 (citing *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974)). Claim 1 of the present invention refers to:

"a light source holder comprising a hollow tube projecting from said base portion, said hollow tube having a first opening at one end of said hollow tube and a second opening at an opposite end of said hollow tube, the hollow tube dimensioned such that the light bulb may not be passed completely through the hollow tube".

As shown in Figure 7 of the present invention, the hollow tube 240 has a first opening 270 and a second opening 250, also called the posterior open end 250 and the anterior open end 270. An electrical connector 260 may be inserted into the hollow tube through the second opening. The light source 290 may then be inserted into the first opening of the hollow tube, where the light source is secured in the hollow tube by the electrical connector. In Figure 7 it is evident that the

light source may not be passed completely through the hollow tube. For example, if the light source were connected to the electrical connector **outside of the hollow tube, the light source/electrical connector combination could not be inserted through the second opening.** In the hypothetical situation provided, the lamp could not be secured by the hollow tube, because it could not fit inside the hollow tube. In actual practice, installation of the light source may be completed by first inserting the electrical connector into second opening on one side of the hollow tube and then inserting the light source into the first opening on the opposite side of the hollow tube such that the light source is connected to the electrical connector inside of the hollow tube. Because of the size of the hollow tube, the light source could not be inserted into the assembly if the light source were attached to the electrical connector outside of the hollow tube.

In contrast, the Goto reference discloses "A bulb 30 arranged by integrally fitting a wedge base bulb body 36 into a bulb socket 32 is fitted into the bulb fitting hole 20 by bayonet engagement" Goto reference, ¶ 0035. "Reference numeral 34 denotes a gasket installed in between a flange portion 33 peripherally fitted to a bulb socket 32 and a peripheral edge portion 21 of the bulb fitting hole." Goto reference, ¶ 0036. As shown in Figure 2 of the Goto reference, the bulb (30) is inserted into a bulb socket (32). The bulb socket (32) and the bulb (30) are thus attached together as a single unit, before insertion into the bulb fitting hole (20). After the bulb (30) and the bulb socket (32) are fitted together, the unit is inserted into the bulb fitting hole (20). A gasket (34) is used to seal the bulb socket (32) against the sides of the bulb fitting hole (20). The bulb and bulb socket are joined together before insertion into the hole (20), and the

bulb/bulb socket assembly is then inserted into the hole. This would not be possible according to claims 1 and 9 because the hollow tube is dimensioned to prevent passage of the larger light source through the hollow tube.

Similarly, the Ohishi patent discloses "a mounting tube 44 which terminates in a bulb entrance end 46. The light bulb 12 is inserted, with its envelope 18 foremost, into the lamp housing 14 through the bulb entrance end 46 until the bulb base 22 becomes seated within the mounting tube 44." Ohishi patent, col. 4, ll. 20-23. As shown in Fig. 2 of the Ohishi patent, the light bulb 12 is joined to a bulb base 32. The light bulb/bulb base combination is then inserted into the mounting tube 44 and is secured. As with the Goto reference, the light bulb and bulb base are joined together before insertion into the mounting tube 44, and the light bulb/bulb base combination is then inserted into the mounting tube. This would not be possible according to claims 1 and 9 because the hollow tube is dimensioned to prevent passage of the larger light source through the hollow tube.

It is respectfully submitted that neither the Goto reference nor the Ohishi patent, alone or in combination, discloses all limitations of Applicant's claimed invention. For example, Applicant's limitation of a light source positioned in a hollow tube that is dimensioned to prevent complete passage of the light source through the hollow tube is not disclosed. Accordingly, Applicant respectfully submits that the Applicant's claim amendments have overcome the Examiner's basis for rejection of claims 1 and 9 under 35 U.S.C. § 103(a), as the Goto reference and the Ohishi patent do not describe every claim limitation of Applicant's Claims 1 and 9.

Thus, Applicant respectfully requests that the Examiner's rejections of Claims 1 and 9 made under 35 U.S.C. § 103(a) be withdrawn.

**B. Rejection of Claims 3 Through 12 Under 35 U.S.C. § 103(a) Should Be
Withdrawn.**

The Examiner has further rejected Claims 3 through 12 under 35 U.S.C. § 103(a). "Claims in dependent form shall be construed to include all the limitations of the claim incorporated by reference into the dependent claim." 37 C.F.R. § 1.75. "If an independent claim is nonobvious under 35 U.S.C. 103, then any claim depending therefrom is nonobvious." M.P.E.P. § 2143.03 (citing In re Fine, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988)).

Each of Applicant's claims 3-8 are dependent claims which depend from independent claim 1. Further, claims 10-12 are dependent claims which depend from independent claim 9. Applicant respectfully submits that the Remarks section (II)(A) hereof shows that independent claims 1 and 9 are not obvious over the Goto reference in view of the Ohishi patent. As a dependent claim includes all of the limitations of the claim from which it depends, Applicant respectfully submits that claims 3 through 12 are also not anticipated by the Goto reference in view of the Ohishi patent. Accordingly, Applicant respectfully requests that the Examiner's rejection of claims 3 through 12 made under 35 U.S.C. § 103(a) be withdrawn.

III. New Claims 13 Through 18 are Submitted.

Applicant respectfully requests examination of new claims 13 through 18 by the Examiner. Applicant respectfully submits that new claims 13-18 include several limitations not disclosed by the prior art. For example, claim 13 includes the limitation that "the anterior open end of the hollow tube [is] substantially smaller in diameter than the opening into the cavity". Accordingly, Applicant respectfully requests allowance of new claims 13-18. Ample support may be found in the Applicant's specification, including the drawings, for the submission of claims 13 through 18.

With new claims 13-18, there are 17 total pending claims (claim 2 was canceled) and 3 pending independent claims. Applicant respectfully submits that no additional fee is required for new claims 13-18, as the total number of pending claims remains less than twenty, and the total number of independent claims is three.

CONCLUSION

For all the foregoing reasons, it is respectfully submitted that Applicant has made a patentable contribution to the art and that this response places the above identified application in condition for allowance, or in the alternative this response places the application in a better form for appeal. Favorable reconsideration and allowance of this application is respectfully requested. Should the Examiner continue to find any of the claims objectionable for any reason, the

Commissioner for Patents
November 7, 2003
Page 13

Examiner is respectfully requested to contact the undersigned for a telephone interview before taking further action.

Applicant respectfully submits that the application as amended contains 3 independent claims and 17 total claims. Therefore, an additional payment is not required. In the event Applicant has inadvertently overlooked the need for an extension of time or payment of an additional fee, Applicant conditionally petitions therefor, and authorizes any fee deficiency to be charged to deposit account 09-0007.

Sincerely,

ICE MILLER



Russell E. Fowler, II

Attorney Registration No. 43,615

ICE MILLER

One American Square, Box 82001

Indianapolis, Indiana 46282-0002

Telephone: (317) 236-5804

Facsimile: (317) 592-4652

Date: 11-7-03

REF/pgf

Enclosures: Return postcard

cc: Mr. Monty Foust